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REMARKS

Claims 1-20 are pending in the application. Claims 1-4, 10-16 and 18-20 stand rejected under 35 U.S.C. §103 as being unpatentable over Harris, U.S. Patent No. 3,013,920 in view of Douglass, U.S. Patent No. 6,205,907. Claims 5 and 6 stand rejected under 35 U.S.C. §103 as being unpatentable over Harris and Douglass, in further view of Chilton, U.S. Patent No. 2,178,953. Finally, claims 5-9 and 17 stand rejected under 35 U.S.C. §103 as being unpatentable over Harris and Douglass, in further view of Voss, U.S. Patent No. 3,797,816.

The Examiner's comments have been carefully considered by Applicant, and Applicant respectfully submits that the case, as presently amended, is in a condition for allowance. Applicant is submitting this Amendment within two months of the date of the Final Office Action such, if necessary, an Advisory Action, can issue. In this regard, the Applicant respectfully requests that the amendments herein be entered because they are clarifying amendments which are consistent with the arguments presented in previous responses. Specifically, the subject matter of claims 3 and 4 has been incorporated into independent claims 1 and 2, respectively. Thus, the claim amendments do not present any new issues for consideration but, rather, clarify the scope of the invention in a manner consistent with the disclosure and arguments previously presented. Applicant further requests that these amendments be entered because they place the case in a condition for allowance, or at least, in a better form for appeal, if necessary.

Claim Rejections Under 35 U.S.C. §103

Applicant traverses the rejections under 35 U.S.C. §103 and maintains that a *prima facie* case of obviousness has not been established. Further, for the reasons set forth below, the combination of references is improper in view of the lack of motivation or suggestion to combine the references.

First, the combination of references fails to disclose or suggest each of Applicant's claimed features. MPEP 706.02(j) and 2143 requires that, to establish a *prima facie* case of obviousness, the prior art reference must teach or suggest all the

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claim limitations. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Here, the combination of references fail to disclose or suggest at least the following features: a method of producing a roll boot for a constant velocity universal joint from an injection molded elastomer wherein the injection molded basic member includes a cylindrical portion; the basic member is turned completely inside out; and, thereafter, a portion of the basic member is folded over (claims 1, 17) or two portions are folded over onto themselves (claims 2, 18) to produce a finished roll boot with certain stages of pre-stress in the material of the roll boot. Further, none of the references relied upon are directed toward Applicant's problem of relieving stresses in the roll wall of the boot for a constant velocity universal joint.

Additionally, Applicant traverses the reasoning in the Office Action that one of skill in the art would be motivated to duplicate the process steps of Harris, but use injection molding as taught by Douglass. Harris discloses a complex manufacturing process to form a multi-ply corded rubber item. In contrast, Douglass discloses an injection molding process to produce a diaphragm of any desired shape (see, for example, Fig. 4 of Douglass) in a final form with no subsequent process steps. Thus, to conclude that one of skill in the art would mold something in final form (Douglass), yet perform additional process steps, as claimed herein, because some of those process steps are disclosed in a process for a product with completely different properties (Harris), cannot be supported.

The Harris reference is directed toward a method of making a flexible diaphragm which, in final form, is closed at one end. The process starts with a strip of corded fabric which is wound along a substantially helical path about a mandrel (Figure 1). The resulting tubular form is then expanded to a symmetrical shape (Figure 2). Thereafter, one end of the product is folded over and drawn along the remainder of the product to obtain a two-ply device (Figure 3). At this point, the product is only at an intermediate stage – it is not a finished product. Further, at this point, the product is only a two-ply corded material product – it is not rubber, it is not elastomer, it is not waterproof. Moreover, it is not intended to be used in this form. Rather, the product is then shaped on another form and equipped with bead wire bundles or solid metal bead wires in an outwardly extending resilient lip at its widened end (Figure 4). The process then

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continues by inverting the product, placing it in another apparatus, and closing off one end (Figure 5). Importantly, all of these steps take place with the rubber in an uncured state. Thereafter, the product is vulcanized (Figure 6). Thus, when finished, the product is completely free of any internal tensions or stress. Indeed, Harris is not concerned with anything other than making a resilient, waterproof diaphragm.

The Douglass reference is cited to show that injection molding is a known technique. Similar to Harris, however, Douglass is not directed toward injection molding of rolling boots for constant velocity joints. Further, Douglass is directed toward producing an item by injection molding in its final shape. Thus, no internal tension or stress is present in the device of Douglass, either.

The conclusion in the Office Action that it would have been obvious to use injection molding as taught by Douglass, yet still perform an inversion step among other things, as taught by Harris, cannot be supported. Accordingly, the rejections under §103 must be withdrawn. Applicant's solution may seem simple, but "Simplicity is not inimical to patentability". *In re Oetiker*, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992).

Further the cases cited in the Office Action do not support the conclusion of obviousness. The natural consequence of combining Harris and Douglass would, at best, result in forming a resilient and waterproof diaphragm in a single injection molding process step. No inversion would be necessary. Further, the references complete lack of recognizing stress-related issues in the roll wall demonstrates that the combination was made only with improper hindsight in view of the present claims. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984). ("It is impermissible to use the patent itself as the source of suggestion."). There is no demonstration that the knowledge necessary to combine the references in the manner suggested comes from anything other than Applicant's solution. Nor do the advantages provided by the presently claimed device naturally flow from following any suggestions contained in Harris or Douglass.

In addition, the claims, as amended, further distinguish over the combination of Harris and Douglass, as neither reference discloses or suggests initially forming the boot to include a cylindrical portion and an adjoining widening cone (claim 1), or a

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cylindrical portion and two adjoining widening cones (claim 2). For these additional reasons, independent claims 1 and 2 and dependent claims 5-16 should be allowed.

Accordingly, Applicant submits that the rejections under 35 U.S.C. §103 should be withdrawn, and a Notice of Allowance indicating the allowability of claims 1, 2 and 5-20 should be issued. The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 223-9500 if any unresolved matters remain.

Respectfully submitted,

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